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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,810	03/24/2004	Michael Albanese	10555-6	4378

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EXAMINER	
DESAI, ANISH P	

ART UNIT	PAPER NUMBER
1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/807,810	ALBANESE ET AL.	
	Examiner	Art Unit	
	Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17,19-23,42 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17,19-23,42 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The applicant's arguments in response to the Office action dated 07/26/06 have been fully considered.

1. Claims 1-16,18, and 24-41 are cancelled. Claims 17, 19-23, 42, and 43 are pending.

2. 112 first paragraph rejections are maintained. 112 second paragraph rejections are withdrawn in view of the present amendment and response (see page 2 of 10/06/06 amendment).

3. All of the art rejections are maintained.

4. Declaration Under 37 CFR Section 1.132 is thoroughly reviewed but not found persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 17,19-21, 22,23, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement substantially as set forth in 07/26/06 Office action. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17 and 22 recite "an unscored length of electrically insulating sheet material", the limitation of "unscored" is a negative limitation which is

not fully supported by the specification of the present invention. Note that the specification does not have a written portion that would clearly suggest that the sheet is not scored or not needed to be scored. An example or drawing merely lacking a feature is not sufficient to support the explicit exclusion of that feature. Any claims containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C 112, first paragraph as failing to comply with the written descrpition requirement. See Ex Parte Grasselli, 231 USPQ 393 (bd. App.1983),aff'd mem., 738 F.2d 453 (Fed. Cir. 1984).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 17,19-23,42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figliuzzi (US 3,537,578) in view of Thomason (US 4,195,787) and Hughey et al. (US 6,596,945 B1) substantially as set forth in 07/26/06 Office action.

Figliuzzi teaches a pressure sensitive adhesive tape such as an insulating tape (Column 1, lines 7-10). Figure 3 of Figliuzzi shows a spiral roll of a tape. The invention of Figliuzzi relates to a new and improved means for marking a tape such that the location of the free end of the tape can be ascertained in order to remove the tape from a roll (Column 1, lines 1-6). The roll of Figliuzzi is not scored (Figures 1, 2,and 4). Additionally, the roll Figure 3 of Figliuzzi shows a spiral roll of a tape with overlying

multiple layers and a free end 13 of the tape, which reads on electrically insulating sheet material having a first side and a second side, and releasably adhered to itself in a spiral roll of overlying multiple layers, the layers extending from a first end interior the roll to a second free end overlying the first side of the next adjacent radially inward layer of material as claimed in claim 17. Further the tape of Figliuzzi has an adhesive coated on one side of the tape (claim 1). Moreover, Figliuzzi teaches that the markings 12 on the tape extends diagonally from one corner of the tape at the end thereof down to the other end thereof at the outer corner of the tape (Column 1, lines 44-47), which reads on pattern extending substantially continuously from said first end to said second end as claimed in claim 17. Further, Figures 1, 2 and 4 along with the claim 4 of Figliuzzi disclose a printed pattern on the tape, which is substantially continuous. Regarding claim 19, although Figliuzzi does not explicitly teach dashed or dotted lines, the patent of Figliuzzi does teach a pattern in the form of a line (Figure 1) on a tape such that the free end of the tape can be easily identified. Once the functional relationship of an indicia and its substrate is met by the prior art, the particular design thereof does not convey patentable weight since printed matter in and itself is not patentable. Thus, in the absence of unexpected results, a skilled artisan can obviously choose the pattern of dashed or dotted lines on the tape of Figliuzzi, motivated by the design aesthetics so long as the function taught by Figliuzzi is not lost, namely free end identification. With respect to claim 20, Figure 2 and claim 4 of Figliuzzi read on the claimed limitation of the pattern at the edge is discontinuous with the pattern on the juxtaposed surface of the next adjacent radially inward layer. With respect to claim 21, Figures 1, 2, and 4 of

Figliuzzi show pattern of a line, a curved line, and a sinusoidal curve. Although Figliuzzi does not explicitly teach the combination of pattern as claimed in claim 21, it is noted that the invention of Figliuzzi is in the same problem solving area as the applicant (i.e. to identify the free end of the tape) and in the absence of any unexpected results with respect to the use of any particular pattern, selecting a combination of patterns involves only a routine skill in the art, motivated by the design aesthetics as set forth above.

Figliuzzi is silent as to teaching of at least two line segments each having color different that that of the first side of the sheet material, an indicia pattern comprising at least two lines wherein each line being a color different than the first solid color of the sheet material, at least two lines are same color, said color being selected from the group consisting of green, white and red, and at least two line segments each has a color different than the other. Again, these features merely express design content of printed matter, the function of which is the identification of a free end of the tape. This function is anticipated by Figliuzzi rendering the specific designs claimed merely printed matter since they impart no additional functioning to the device, in the alternative. Thomason teaches rolled products (Column 1, lines 25-26) such as tissue paper, friction tape, electrical tape etc. (Column 1, lines 7-10). The invention of Thomason provides marking arrangements, which permits easy access to the beginning or the front part of the rolled product (Column 1, lines 11-13). In Figures 1-7, especially Figures 1-4, Thomason shows decorative lines (also called by marking or pattern by Thomason) (Column 1, line 19). Further, Figures 1 and 2 of Thomason seem to show plurality of lines that are side by side or in a spaced apart relationship. Thus, a skilled artisan

would have found it obvious to use at least two line segments in the invention of Figliuzzi, motivated by the desire to enhance the aesthetics and to easily locate the free end of the tape of Figliuzzi. Additionally, Figliuzzi as modified by Thomason is silent as to teaching of line segments each having color different than that of the first side of the sheet material, two lines having same color wherein each color being selected from green, white, and red, and at least two line segments each has a color different than the other. However since Figliuzzi and Thomason are concerned with the same problem as applicant, namely to provide a roll of a tape with a pattern such that the free end of the tape is easily visible to a user. Therefore, it is the examiner's position that the choice of a color involves only routine skill in the art and is not considered to be a patentable feature over the prior art. As such, a skilled artisan would have found it obvious to select line segments each having color different than that of the first side of the sheet material, two lines having same color wherein each color being selected from green, white, and red, and at least two line segments each has a color different than the other, motivated by desire to easily identify the free end of the tape.

Figliuzzi as modified by Thomason is silent as to teaching of insulating sheet material is formed of a solid color. However, Hughey teaches a novel process or method which produces polymeric tapes such as an insulating tape (Column 7, lines 22-23 and Column 9, line 8). At column 8,lines 51-65, Hughey teaches of adding color dyes in specific quantities to a transparent backing of the tape so that the operator can easily distinguish the edges of the immediate previous layers of the tape from those of the earlier layer. Thus, a skilled artisan would have found it obvious to add dyes in the

tape of Figliuzzi and provided solid color to the tape of the Figliuzzi, motivated by the desire to easily identify the free end of the tape from the immediate previous layer of the said tape.

Response to Arguments

7. Applicant's arguments filed 06/01/06 have been fully considered but they are not found persuasive.

The 112 first paragraph rejections are maintained for the following reasons. The applicant asserts that it would be understood by one of ordinary skill in arts relating to insulation that any perforation (scoring) in an insulating layer is a defect because electrical charge can pass through. Additionally, the applicant asserts that the negative limitation "unscored" does not introduce a new concept (pages 1-2 of 10/06/06 amendment) and therefore the rejection should be withdrawn. The examiner respectfully disagrees. To the examiner, the recitation "unscored" is a new concept and the specification does not provide any support for this recitation, specifically there is nothing in applicant's disclosure suggesting one should deliberately exclude scoring. Additionally, as to the applicant's assertion that insulating tapes are not perforated, the US Pat 497,336, discloses a perforated (scored) tape that is used in insulating the wires of Telegraph-Cables (please see the entire patent). Thus, contrary to the applicant's assertion, it appears that the insulating tapes can be perforated (scored) and to "unscore" the tape is considered as introducing a new concept that would not necessarily be the natural conclusion of one skilled in the art reading applicant's disclosure. Accordingly, 112 rejections are maintained.

Art rejections of Figliuzzi in combination with Thomason and Hughley are maintained for the following reasons. The applicant argues that none of the cited references disclose two lines each running the entire length of the tape. Additionally, the applicant asserts that the secondary reference of Thomason may have some segments with two lines, the present claims require that any arbitrary segment to have two lines. The applicant then concludes that the reference of Thomason teaches away from the claimed limitation by disclosing segments having only one line (page 3 of 10/06/06 amendment). The examiner respectfully disagrees. The primary reference of Figliuzzi already discloses a single line segment running from one end of the tape to the other end of the tape (column 1, lines 44-47). Additionally, the primary reference of Figliuzzi is working to solve the same problem as the applicant (i.e. finding a free end of the tape). The difference between the invention of Figliuzzi and the claimed invention is that Figliuzzi does not teach all of the design elements of the printed matter instantly claimed. However as the function of printed matter combined with the substrate is anticipated by Figliuzzi, the particular design employed constitutes only printed matter and does not further contribute utility to the device. Regardless, Thomason discloses two line segments that are at least on one segment of the toilet paper of Thomason. Additionally, Thomason further contributes utility to the device. Regardless, Thomason is working to solve the same problem as the applicant (i.e. finding a free end of a spiral wound roll of sheet material). Since, Figliuzzi already discloses single line extending from one end of the tape to the other (i.e. function of the printed matter), putting a second line on the tape of Figliuzzi as taught by Thomason involves only a routine skill

in the art. Additionally, contrary to the applicant's argument that Thomason teaches away by disclosing segments having only line is not found persuasive because Thomason does not teach or suggest anywhere in his disclosure that one of ordinary skill in the art should not create two lines on a tape or on a segment of a tape.

The applicant argues that none of the cited references addresses the problem of unwinding the tape from a spliced connection (page 3 of 10/06/06 amendment). The examiner respectfully disagrees for the following reasons. First, as stated in the page 9 of 7/26/06 Office action, the argument of unwinding the tape from a spliced connection is not in commensurate in scope with the claims because nothing in claims teaches or suggests anything about unwinding the tape from a spliced connection. Second, both references of Figluzzi and Thomason relate to finding a free end of a tape. Therefore, the tape of Figluzzi and Thomason, whether on a roll or on a spliced connection are equally capable of allowing one to identify the free end and thus unwind the tape if desired.

The applicant argues that the reference of Hughley (Hughey) is concerned with the manufacture of a cable and not with unwinding of the tape from a cable. The examiner respectfully disagrees. As previously noted, said arguments regarding unwinding a tape are not found persuasive in determination of patentability because the arguments are not in commensurate in scope with the claims. Additionally, Hughey also teaches process of producing polymeric tapes (column 7, lines 21-25). The applicant asserts that Hughey's teaching of adding dye to color a transparent tape does not result in the Figluzzi tape as the rejection suggest. The examiner respectfully disagrees. The

reference of Hughey is relied upon only to teach the claim limitation of insulating sheet material formed of a solid color (please see page 7 of 07/26/06 Office action). Accordingly, art rejections are maintained. Alternatively, note that the primary reference of Figluzzi inherently discloses solid color insulating sheets because there is no disclosure in Figluzzi to produce non-solid color insulating sheets.

Declaration Under 37 CFR Section 1.132

The Declaration under 37 CFR 1.132 filed on 10/10/06 is insufficient to overcome the rejection of claims 17, 19-23, 42-43 as set forth in the last Office action because:

The declaration is submitted with respect to the usefulness of the invention and/or long felt need for a solution to the problem (page 1 of 10/06/06 amendment). As to the usefulness of the invention, the examiner agrees with the applicant that the invention is useful.

With respect to the long felt need, the declaration is not found persuasive in demonstrating that the claimed subject matter solved a problem that was long standing in the art for the following reasons.

(A) The language of the declaration appears to be contrived and does not appear to be the actual language of the declarant.

(B) There is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. The declaration only shows that the declarants seems to have liken the idea of a tape having two colored wavy lines along the entire length of the tape, because such tape is useful in locating the free end of the tape while the tape

is on the roll or on a splice. The examiner agrees that such tape can be useful but this does not establish that there was a long felt need.

(C) There is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the prior art of record, they would still be unable to solve the problem. See MPEP § 716.04. And

(D) The problem of finding the free end of a tape was already solved by Figluzzi even if that product was not successfully brought to market.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD

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